

(f) sending pre-recorded voice associated with the store to the connected terminal; and

*03  
cont.* (g) transmitting a payment approval data containing information on the amount of money approved to the connected terminal.

---

A marked-up copy of the amended claims is attached as required under 37 C.F.R. § 1.121.

#### REMARKS

The following remarks are fully and completely responsive to the Office Action dated October 8, 2002. Claims 1-17 are pending in this application. In the outstanding Office Action, the Abstract was objected to; claims 1-17 were objected to; claims 1, 4-7, 9-12, 13, 15 and 17 were rejected under 35 U.S.C. § 102(e); and claims 2, 3, 14 and 16 were rejected under 35 U.S.C. § 103(a) (two different rejections). No new matter has been added. Claims 1-17 are presented for reconsideration.

#### **Abstract**

The Abstract of the disclosure was objected to because it exceeded 150 words in length. The new Abstract provided with this Response provides a Substitute Abstract which is less than 150 words in length. Accordingly, Applicants respectfully request reconsideration and withdrawal of the objection to the Abstract.

## **Claim Objections**

Claims 1-17 were objected to because they were not submitted on a separate sheet. Attached to this Response is a copy of claims 1-17 submitted on separate sheets. These claims include the amendments recited above for the Examiner's convenience. Accordingly, Applicants respectfully request reconsideration and withdrawal of the objection to claims 1-17.

## **35 U.S.C. § 102(e)**

Claims 1, 4-7, 9-12, 13, 15 and 17 were rejected under 35 U.S.C. § 102(e) as being anticipated by Davis (U.S. Patent No. 6,282,522). In making this rejection, the Office Action asserts that this reference teaches each and every element of the recited invention. Applicants respectfully request reconsideration of this rejection.

Claim 1 recites a method of paying for goods or services by using a mobile phone. This method includes submitting payment request data containing information identifying a store and a buyer and an amount of money to be paid from the mobile phone to a payment transaction server over a mobile telephone network. At the payment transaction server, the payment request data received and a balance associated with the identified buyer is checked for approval of the payment. Payment approval data containing information on the amount of money approved is transmitted from the payment transaction server to a terminal other than the mobile phone based on the checked result. The terminal is designated from pre-registered information for the identified store.

Davis teaches an internet payment system using a smart card. This system includes a stored value card 5 which may also be a smart card that is read by a card reader 210. The card reader 210 is connected to a client terminal 204. Client terminal 204 communicates with a payment server 206 and a merchant server 208 using an open network such as the internet.

In Davis, the user accesses a merchant web site using the client terminal which may be a mobile phone. After selecting goods and/or services at the merchant website, the user designates that he/she wishes to pay for the purchase using a stored-value card. After receiving the purchase request, the merchant web server builds an HTML page that includes data associated with the transaction, including the IP address of the payment server and a unique transaction identifier that would be used by both the payment server and the merchant server to track the transaction. Once the page has been constructed, it is sent to the client browser on the client terminal and triggers the loading of the client code module.

The client module disclosed in Davis interacts with the stored-value card 5 to obtain card information in order to build a draw request for transmission to the payment server. Thereafter, the client terminal sends the draw request to the IP address of the payment server. The payment server processes this request in conjunction with an associated security card.

The payment server disclosed in Davis then sends the debit command, along with the security card signature, to the client terminal so that the stored-value card will debit itself. Upon receiving the debit command from the payment server, the client module of the client terminal replaces the amount in the debit command with the original

amount received from the merchant server to ensure that the amount has not been tampered with. Then the client module passes the debit command and security card signature to the stored-value card 5 which verifies the signature and debits itself by the purchase amount.

Thereafter, the stored-value card 5 in Davis also generates a success message and a stored-value card signature. The stored-value card 5 then sends the success message, along with the card signature, back to the client module in client terminal 204. The success message and card signature are packaged by the client terminal and sent back to the payment server 206. Thereafter, the payment server processes and validates the success message.

The payment server in Davis then sends a confirmation message to the client terminal. The client terminal then forwards a confirmation message to the merchant server at the URL address previously received from the merchant server. After validating the confirmation message, the merchant server generates an HTML page with the purchase information and delivers this information to the client terminal. Alternatively, the merchant server may generate a purchase receipt to be delivered to the client terminal.

The process described in Davis is a multi-step process that requires a stored-value card. The stored-value card contains the "money" used to make purchases. In contrast, the present invention does not require a stored-value card. In the present invention, an account is established at the payment transaction server.

It appears that the draw request sent from the client terminal to the payment transaction server in Davis contains information identifying a store, a buyer and an

amount of money to be paid. The payment transaction server, however, fails to check the payment request data received and a balance associated with the identified buyer for approval of the payment.

In response to the draw request, the payment server in Davis generates a debit command. This debit command, however, is sent from the payment transaction server back to the client terminal. Accordingly, Davis fails to teach and/or suggest transmitting a payment approval data containing information on the amount of money approved from the payment transaction server to a terminal other than the mobile phone based on the checked result.

As discussed above, Davis fails to teach and/or suggest the present invention. Specifically, Davis fails to teach and/or suggest, at the transaction server, checking the payment request data received and a balance associated with the identified buyer for approval of the payment. Davis also fails to teach and/or suggest transmitting a payment approval data containing information on the amount of money approved from the payment transaction server to a terminal other than the mobile phone based on the checked result, the terminal being designated from pre-registered information on the identified store. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 4-7, 9-12, 13, 15 and 17 under 35 U.S.C. § 102(e).

### **35 U.S.C. § 103(a)**

Claims 3, 14 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Davis (discussed above). In making this rejection, the Office Action

asserts that this reference teaches and/or suggests each and every element of the recited invention. Applicants respectfully request reconsideration of this rejection.

As discussed above, Davis fails to teach and/or suggest, at the payment transaction server, checking the payment request data received and a balance associated with the identified buyer for approval of the payment. Davis also fails to teach and/or suggest transmitting a payment approval data containing information on the amount of money approved from the payment transaction server to a terminal other than the mobile phone based on the checked result, the terminal being designated from pre-registered information on the identified store. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 3, 14 and 16 under 35 U.S.C. § 103(a).

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Davis (discussed above) in view of Rossmann (U.S. Patent No. 6,405,037). In making this rejection, the Office Action asserts that the combination of these two references teaches and/or suggests each and every element of the claimed invention. The Office Action also asserts that it would be obvious to one of ordinary skill in the art to combine these two references. Applicants respectfully request reconsideration of this rejection.

The Office Action admits that Davis fails to teach that the data communication uses a Code Division Multiple Access (CDMA) mobile telephone network. The Office Action cites Rossmann as correcting this deficiency in Davis. While Rossmann may correct the deficiency cited in Davis, Rossmann is not cited for, nor does Rossmann correct, the deficiencies discussed above in Davis.

Accordingly, the combination of Davis and Rossmann fails to teach and/or suggest the recited invention. Specifically, the combination of these two references fails to teach and/or suggest, at the payment transaction server, checking the payment request data received and a balance associated with the identified buyer for approval of the payment. The combination of these two references also fails to teach and/or suggest transmitting a payment approval data containing information on the amount of money approved from the payment transaction server to a terminal other than the mobile phone based on the checked result, the terminal being designated from pre-registered information on the identified store. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 2 under 35 U.S.C. § 103(a).

## **Conclusion**

Applicants' amendments and remarks have overcome the objections and rejections set forth in the Office Action dated October 8, 2002. Specifically, Applicants' replacement Abstract overcomes the objection to the Abstract. Applicants' submission of claims 1-17 on a separate sheet overcomes the objection to these claims. Applicants' remarks have distinguished claims 1, 4-7, 9-12, 13, 15 and 17 from Davis and thus overcome the rejection of these claims under 35 U.S.C. § 102(e). Applicants' remarks have also distinguished claims 3, 14 and 16 from Davis and thus overcome the rejection of these claims under 35 U.S.C. § 103(a). Applicants' remarks have also distinguished claim 2 from the combination of Davis and Rossmann and thus overcome the rejection of this claim under 35 U.S.C. § 103(a). Accordingly, claims 1-17 are in

condition for allowance. Therefore, Applicants respectfully request consideration and allowance of claims 1-17.

Applicants submit that the application is now in condition for allowance. If the Examiner believes that the application is not in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned attorney by telephone if it is believed that such contact will expedite the prosecution of the application.

The Commissioner is authorized to charge payment for any additional fees which may be required with respect to this paper to our Deposit Account No. 01-2300, making reference to attorney docket number 108256-09004.

Respectfully submitted,



---

Rustan J. Hill  
Registration No. 37,351

Customer No. 004372  
AREN'T FOX KINTNER PLOTKIN & KAHN, PLLC  
1050 Connecticut Avenue, N.W.,  
Suite 400  
Washington, D.C. 20036-5339  
Tel: (202) 857-6000  
Fax: (202) 638-4810

RJH:elz  
Enclosures: Marked-Up Copy of Amended Claims  
Claims 1-17 on Separate Sheets  
Replacement Abstract  
Notification of Change of Name and Address

**MARKED-UP COPY OF AMENDED CLAIMS**  
**AS REQUIRED UNDER 37 C.F.R. § 1.121**

Please amend claims 1, 4, 5 and 13 as follows:

1. (Amended) A method of paying for a goods or service by using a mobile phone, comprising the steps of:

[(a) connecting to a payment transaction server through the mobile phone;]

[(b)] transmitting [a] payment request data containing information identifying a store and a buyer and an amount of money to be paid from the mobile phone to a payment transaction server over [through] a mobile phone network;

[(c)] at the payment transaction server, checking the payment request data received and a balance associated with the identified buyer for approval of the payment; and

[(d)] transmitting a payment approval data containing information on the amount of money approved from the payment transaction server to a terminal other than the mobile phone based on the checked result, the terminal being designated from pre-registered information on the identified store.

4. (Amended) A method according to claim 1, wherein said checking step [(c)] comprises:

transmitting the information on the amount of money to be approved to the mobile phone through the mobile phone network;

receiving a data indicating whether the amount of money to be approved is correct or not from the mobile phone; and

determining whether to approve the payment depending upon the received data.

5. (Amended) A method of paying for a goods or service by using a mobile phone, comprising the steps of:

(a) receiving at a payment transaction server a payment request data containing information identifying a store and a buyer and an amount of money to be paid from the mobile phone connected;

(b) identifying a buyer's account depending upon the information identifying a buyer;

(c) determining whether to approve the payment based on the received amount of money to be paid and the balance in the identified buyer's account;

(d) identifying a terminal of the store depending upon the information identifying a store; and

(e) transmitting a payment approval data containing information on the amount of money approved from the payment transaction server to the identified terminal.

13. (Amended) A method of paying for a goods or service by using a mobile phone, comprising the steps of:

(a) receiving at a payment transaction server a payment request data containing information identifying a store and a buyer and an amount of money to be paid from the mobile phone connected;

(b) identifying at the payment transaction server a buyer's account depending upon the information identifying a buyer;

- (c) determining at the payment transaction server whether to approve the payment based on the received amount of money to be paid and the balance in the identified buyer's account;
- (d) identifying a terminal of the store depending upon the information identifying a store;
- (e) connecting to the identified terminal;
- (f) sending pre-recorded voice associated with the store to the connected terminal; and
- (g) transmitting a payment approval data containing information on the amount of money approved to the connected terminal.